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09/593,645	06/13/2000	Joseph A. Manico	81254F-P	7582

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PATENT LEGAL STAFF
EASTMAN KODAK COMPANY
343 STATE STREET
ROCHESTER, NY 14650-2201

EXAMINER

HENDERSON, MARK T.

ART UNIT

PAPER NUMBER

3722

DATE MAILED: 12/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/593,645

Applicant(s)

MANICO ET AL.

Examiner

Mark T Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 11 September 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 and 44-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-34 and 44-47 is/are rejected.
- 7) ☒ Claim(s) 15-18 and 27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 June 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. In view of the Appeal Brief filed on September 11, 2002, PROSECUTION IS HEREBY REOPENED. A new office action is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

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If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “fold line disposed substantially co-extensive with a line formed by said ends” as stated in Claim 13 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

3. Claims 15-18 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel

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the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Independent claim 10 is directed to a “dual sided folded image product” whereas dependent claims 15-18 are directed to a “dual sided composite image product”.

4. Claim 27 objected to because of the following informalities: Claim 27 is a duplicate of claim 8. The examiner is assuming that applicant meant “according to claim 20”. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10-18 and 23-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. In Claim 10, line 6, it is not understood what is meant by “side sections being folded on said”.

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6. Claim 12 recites the limitation "side sections having an end that is substantially about each other" in line 2. There is insufficient antecedent basis for this limitation in the claim. In the specification on page 7, lines 13-17, the applicant discloses that the ends "abut" each other. The examiner interprets this to mean that there is no space between the ends when the side sections are folded. Webster's Dictionary defines "about" to mean "in the vicinity" or "reasonably close". This is interpreted to mean that there is a space between the ends when folded. How can there be a space between the side section ends when folded, when applicant has disclosed in the specification that the ends "abut".

7. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. It is not understood what type of "line" applicant is talking about. Is the line a "fold line" or an "indicated line", and where in the drawings and specification is it located?

8. Claim 14 recites the limitation "side sections having an end which overlaps each other" in line 2. There is insufficient antecedent basis for this limitation in the claim. The specification discloses that the ends "abut" each other, so it is not understood how one end "overlaps" the other end.

9. Claim 18 recites the limitation "said composite image product" in line 2. There is insufficient antecedent basis for this limitation in the claim.

10. Claim 19 recites the limitation "said composite image product" in line 2. There is insufficient antecedent basis for this limitation in the claim.

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11. Claim 23 recites the limitation "said first and second substrates" in line 2. There is insufficient antecedent basis for this limitation in the claim.

12. Claim 24 recites the limitation "said first and second substrates" in line 2. There is insufficient antecedent basis for this limitation in the claim.

13. Claim 25 recites the limitation "said first and second substrates" in line 2. There is insufficient antecedent basis for this limitation in the claim.

14. Claim 29 recites the limitation "said dual sided integral composite image product" in line 11. It is not understood how the "dual sided integral composite image product" is the same for the leaf as it is for the cover. Does applicant mean "a second dual sided integral composite image product"? There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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15. Claims 1, 2, 4, 5, 8, 9 and 47 are rejected under 35 U.S.C. 102(b) as being anticipated by Applebaum et al (4,183,162).

Applebaum et al discloses in Fig. 4-6, an image product comprising: a first support substrate (34) having a separate image layer (ink layer which forms the picture); a second support substrate (26) having a separate image layer (ink layer which forms the picture); the second support substrate secured to the first support substrate to form a dual sided integral composite image product (30, as seen in Fig. 4 and 6, and in Col. 5, lines 25-28); said image product having a plurality fold lines (G and G') about which the image product may be folded; wherein the substrates are made from a photographic media and paper; a cover (20, as seen in Fig. 4) for holding a leaf (8 and 10); and wherein the composite image product comprises a free standing product (Fig. 4).

16. Claims 10-14, 18-22, 27, 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Viesturs et al (4,350,195).

Viesturs et al discloses in Fig. 1 and 2, an image product comprising: a sheet (24, 25, 26) having a first side and a second side, wherein the first side has an image layer (imaged document which is considered to be a layer) separate from the sheet (separate document is placed in sheet pocket); the sheet having fold lines (F) which form a central section (24B) and a first side section (24A) and a second side section (24C); wherein the central section (24B) is positioned between the first (24A) and second (24C) side sections; the side sections are folded so that the image layer

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(document) is exposed; wherein the side sections cover the central section (as seen in Fig. 2); wherein the side sections have an end (A1 and A3) which is **about** and **overlaps** each other; wherein the image product further comprises a free standing binder having a cover (10 and 12) for holding one leaf (Fig. 8).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Applebaum et al.

Applebaum et al discloses an image product comprising all the elements as claimed in Claim 1, and as set forth above. However, Applebaum does not disclose: wherein the first and second substrates are made from a thermal media and the image comprises a photographic emulsion layer.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the substrates and image layer in any desirable material, since it has been

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held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

18. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Applebaum et al in view of Ohtake et al (4,720,733).

Applebaum et al discloses an image product comprising all the elements as claimed in Claim 1, and as set forth above. Applebaum further discloses that the print can further be made into numerous panels in which they are separated by a fold line (Col. 5, lines 55-65).

However, Applebaum does not disclose: wherein the image product allows for a Z-type fold.

Ohtake et al discloses in Fig. 2 and 3, an image product which allows for a Z-type fold.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Applebaum's image product to include a Z-type fold as taught by Ohtake et al for the purpose of folding the image product into a compact position.

19. Claims 15-17 and 23-26, as best understood are rejected under 35 U.S.C. 103(a) as being unpatentable over Viesturs et al.

Viesturs et al discloses an image product comprising all the elements as claimed in Claim 10, and as set forth above. However, Viesturs et al does not disclose: wherein the sheet is made from photographic paper, thermal media, or includes photographic emulsion layer.

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the sheets in any desirable material to display an image, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

20. Claims 29-33, 44-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hambright (6,164,859) in view of Pearce et al (6,076,989).

Hambright discloses in Fig. 1, 2 and 4, an image product comprising a cover (40 and 42); at least one leaf (10) or a plurality of leaves having an opening (90), a first support substrate (62) having a separate image layer (16); wherein the first support substrate is secured (through 103) to a second support substrate (64) having a separate image layer (16), so as to form a dual sided integral composite image product; an ring attaching member (48) for securing the leaf to the cover (40).

However, Hambright does not disclose a composite cover having a first support substrate having a separate image layer; a second support substrate having a separate image layer; wherein the first substrate is secured to the second substrate to form a dual sided composite image product; and wherein the composite image product has a fold line to be folded.

Pearce et al discloses Fig. 1, a composite cover comprising: a first support substrate (22) having a separate image layer (48); a second support substrate (18) having a separate image layer

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(43); wherein the first substrate is secured (through crease 42) to the second substrate to form a dual sided composite image product; and wherein the composite image product has a fold line (crease 42) to be folded.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hambright's image product by the cover with a dual sided cover having separate images as taught by Pearce et al for the purpose of describing the contents between the covers.

21. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hambright in view of Pearce et al and further in view of Hansen (6,196,750).

Hambright as modified by Pearce et al discloses an image product comprising all the elements as disclosed in Claims 29 and 31-33, and as set forth above. However, Hambright and Pearce et al do not disclose a scored line on the leaf with the opening allowing the leaf to be installed.

Hansen discloses in Fig. 1, an image product leaf (wherein the image product consist of the final product of the support substrate (10) and the image layer document (not shown) placed on the support substrate) having scored lines (11) with the opening.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hambright's and Pearce et al's image product to include scored

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lines with the opening as taught by Hansen for the purpose of assisting with the removal of the leaf.

Response to Arguments

22. Applicant's arguments with respect to claims 1-47 have been considered but are moot in view of the new ground(s) of rejection.

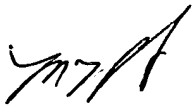
Prior Art References

The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. Cherry, Hollander, Bradley, Ohtake et al, Bachrach et al, Ferra, Willard, Gamer et al, Komori, Morse disclose image products

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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

November 23, 2002



A. L. WELLINGTON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700